UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,350	03/20/2001	Susan Lindquist	HO-P01979US2	1595

26271 7590 10/06/2003

FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER	
BAUM, STUART F	

ART UNIT	PAPER NUMBER
1638	10

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/812,350	LINDQUIST ET AL.	
	Examiner	Art Unit	
	Stuart F. Baum	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 March 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-28* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, and 27-28 drawn to a transgenic plant comprising a nucleic acid sequence encoding a plant HSP 100 amino acid sequence, and method of increasing stress tolerance of a plant, classified in class 800, subclass 278 for example.

If Applicant elects Group I, Applicant is also to elect 2 SEQ ID NO's. One amino acid sequence from the SEQ ID NO's listed in claim 2 and one corresponding nucleic acid sequence from the SEQ ID NO's listed in claim 4.

II. Claims 17 and 18, drawn to a method of producing oil from a plant, classified in class 426, subclass 61 for example.

III. Claim 19, drawn to a method of making a synthetic product from a plant, classified in class 435, subclass 61 for example.

IV. Claim 20, drawn to a method of making an environmental waste absorbing plant, classified in class 435, subclass 468 for example.

V. Claim 21, drawn to a method of making a medicinal plant, classified in class 435, subclass 468.

VI. Claims 22 and 23, drawn to a method of making animal feed from a plant, classified in class 426, subclass 54 for example.

VII. Claim 24, drawn to a method of making alcohol from a plant, classified in class 435, subclass 142 for example.

VIII. Claims 25 and 26, drawn to a method of utilizing a recreational plant, classified in class 435, subclass 468 for example.

2. Applicant is reminded that nucleotide sequences encoding different are structurally distinct chemical compounds and are unrelated to one another, as are different proteins structurally distinct chemical compounds and unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434). This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the transgenic plant of Group I can be used in a materially different process. The transgenic plant of Group I can be used in a method of making a synthetic

product, of removing environmental waste, or of making a medicinal plant, or of making animal feed from a plant, or of making alcohol from a plant, or of utilizing a recreational plant.

4. Inventions I and II-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product. The transgenic plant of Group I can be used in processes that produce different products, each having different uses, as discussed above.

5. Inventions II-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and effects. Each of the different methods of Groups III-IX start with different transgenic plants, and produce different products. The method of Group II cannot use the non-oil producing plants used in the methods of Groups III-IX. The extraction of oil of the method of Group II is also not required by the methods of the other groups. Similarly, the method of making a synthetic product of Group III does not require preparing the non-synthetic product producing plants by the methods of the other groups, and the preparation of the synthetic product of Group III is not required by the other groups. The method of making an environmental waste absorbing plant by the method of Group IV does not require preparing the non-environmental waste absorbing plant by the methods of the other groups, and the preparation of the environmental waste absorbing plant is not required by the other groups. The method of

making a medicinal plant by the method of Group V does not require preparing the non-medicinal plant by the methods of the other groups, and the preparation of the medicinal plant is not required by the other groups. The method of making an animal feed from a plant by the method of Group VI does not require preparing the animal feed plant from a non-animal feed plant by the methods of the other groups, and the preparation of the animal feed plant is not required by the other groups. The method of making alcohol from a plant by the method of Group VII does not require preparing the alcohol plant by the methods of the other groups, and the preparation of the alcohol plant is not required by the other groups. The method of utilizing a recreational plant by the method of Group VIII does not require preparing the recreational plant by the methods of the other groups, and the preparation of the recreational plant is not required by the other groups.

6. Each of Inventions I-VIII are capable of being separately made, independently used, and the patentability of one does not render the others obvious or unpatentable.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search (both literature and sequence), and classification, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart Baum whose telephone number is (703) 305-6997. The examiner can normally be reached on Monday-Friday 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 or (703) 305-3014 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, who may be contacted at 308-0196.

Stuart Baum Ph.D.

September 30, 2003

ASHWIN D. MEHTA, PH.D
PATENT EXAMINER